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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,661	02/15/2007	Yoav Bar-Yaakov	0-06-112	5008
42009	7590	11/15/2010		
KEVIN D. MCCARTHY ROACH BROWN MCCARTHY & GRUBER, P.C. 424 MAIN STREET 1920 LIBERTY BUILDING BUFFALO, NY 14202				
EXAMINER				
BUE-HATCHER, NICOLE M				
ART UNIT		PAPER NUMBER		
1767				
MAIL DATE		DELIVERY MODE		
11/15/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/580,661

Applicant(s)

BAR-YAAKOV ET AL.

Examiner

NICOLE M. BUJE-HATCHER

Art Unit

1767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 6-21, 25 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 and 32-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6-13, 25 and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/21/2010 has been entered.

Response to Amendment

The amendment filed 09/21/2010 has been entered. **Claims 1, 2, 4, 6-21, 25, 27-36** remain pending. **Claims 14-21 and 32-36** were previously withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6, 7, 11, 25, 27, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitahara et al. (US 6,503,988 B1).

Regarding claims 1, 2, 4, 6, 25, 27, Kitahara et al. discloses in Test Example 3, Antidripping Performance Test II, a composition comprising a brominated epoxy resin and a fine

powder of Example 1, which is a tetrafluoroethylene/chlorotrifluoroethylene copolymer. The mixture is subjected to compound-pelletization in a kneading and extruding machine. Therefore, a solid suspension of the fluoropolymer and brominated epoxy resin wherein the flame retardant would envelope the fluoropolymer powder and the fluoropolymer powder would be evenly dispersed in the flame retardant would result. Since the shape of the block is not specified, the pelletized compositions would meet the claimed limitations. The fine powder is an antidripping agent (C2/L51-61).

Although, Kitahara et al. does not disclose the composition is for easily compounding and evenly dispersing within a base thermoplastic resin, the recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). See MPEP § 2111.02. Therefore, the composition of Kitahara et al. anticipates the claimed composition.

Regarding claims 7 and 28, the amount of the fluoropolymer present in the composition is 0.3 wt% based on the total amount of all the components which is within the claimed range.

Regarding claim 11, Kitahara et al. discloses known additives, such as ultraviolet absorber, antioxidant, pigment, molding aid, calcium carbonate and glass fiber may be added to the composition (C6/L31-35).

Claims 9, 10, 12, 13, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitahara et al. (US 6,503,988 B1) as shown above in claims 1 and 2 in view of evidence by Kukdo, YDB-408, Brominated Epoxy Resin.

Regarding claims 9 and 30, Kitahara et al. discloses a composition as shown above in claim 1. The softening temperature of EPOKUKDO YDB-408 used in Kitahara is 102-112°C; therefore the melting point is well below 300°C of the instant claim.

Regarding claims 10 and 31, Kitahara et al. discloses a composition as shown above in claim 1. The softening temperature of EPOKUKDO YDB-408 used in Kitahara is 102-112°C; therefore the melting point is well below 300°C of the instant claim.

However, Kitahara et al. does not disclose the flame retardant is obtained from precursors having a melting point below 300°C. Regarding the method limitations, the examiner notes that even though a product-by-process is defined by the process steps by which the product is made, determination of patentability is based on the product itself. *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). As the court stated in *Thorpe*, 777 F.2d at 697, 227 USPQ at 966 (The patentability of a product does not depend on its method of production. *In re Pilkington*, 411 F. 2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process). See MPEP § 2113.

Regarding claims 12 and 13, Kitahara et al. discloses a composition as shown above in claim 1. The equivalent MW (EEW) of EPOKUKDO YDB-408 is 690-750 which corresponds to a molecular weight of 1380-1500. According to the materials used in Table 1 of the instant specification, the MW of F-3020 ex DSBG is an endcapped brominated epoxy oligomer with a MW of 2,000. Since the molecular weight of the flame retardant of Kitahara et al. is well below this molecular weight, the melt viscosity will be lower than 2000 cp, absent objective evidence to the contrary.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitahara et al. (US 6,503,988 B1) as applied to claim 7 above.

Regarding claim 8, Kitahara et al. discloses a composition as shown above in claim 7. Kitahara et al. discloses the amount of antidripping agent ranges from 0.03 to 2 parts per 100 parts of a flammable thermoplastic resin (C5/L45-53). Therefore, the amount of antidripping agent as shown above in claim 7 could increase up to 1.5 wt% of the composition. It would have been obvious to one of ordinary skill in the art to increase the amount of fluoropolymer in order

to improve antidripping properties. Thus, it would have been obvious to increase the amount of fluoropolymer of Kitahara et al. within the claimed range.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitahara et al. (US 6,503,988 B1) as applied to claim 28 above.

Regarding claim 29, Kitahara et al. discloses a composition as shown above in claim 28. Kitahara et al. discloses the amount of antidripping agent ranges from 0.03 to 2 parts per 100 parts of a flammable thermoplastic resin (C5/L45-53). Therefore, the amount of antidripping agent as shown above in claim 7 could increase up to 1.5 wt% of the composition. It would have been obvious to one of ordinary skill in the art to increase the amount of fluoropolymer in order to improve antidripping properties. Thus, it would have been obvious to increase the amount of fluoropolymer of Kitahara et al. within the claimed range.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 4, 6-13, 25, and 27-31 have been considered but are moot in view of the new ground(s) of rejection. The following comment(s) apply:

A) The declaration filed on 09/21/2010 is moot in regards to new ground(s) of rejection in light of Applicant's amendment.

B) Applicant's argument that in respect to the teachings of Kitahara et al., that the instant invention solves the problem of evenly dispersing the PTFE powder (page 2) is not persuasive.

As shown above in claim 1, since Kitahara et al. discloses a composition which would evenly dispersed, the claimed limitation is met.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE M. BUIE-HATCHER whose telephone number is (571)270-3879. The examiner can normally be reached on Monday-Thursday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1767

/N. M. B./
Examiner, Art Unit 1767
10/29/2010